

**REMARKS****Telephonic Interview**

As an initial matter, the Applicant would like to thank Examiner Koppikar and Examiner Thomas for the telephone interview on Friday November 18, 2005. Jon Gibbons, attorney for the Applicant, participated in the telephone call. A draft of the independent claims with revisions were discussed with the additional language of "pre-qualify finance~~[[e]]~~ing for at least one medical procedure under consideration ~~[[for]]~~by said person." The discussion began with a procedural issue, the finality of the September 8, 2005 Office Action. The Examiner made the Office Action final based on a new ground of rejection not stated in the earlier Office Action. The Applicant respectfully points out that the Boyer reference was not cited in any previous Office Action. Examiner Koppikar and Examiner Thomas agreed to withdraw the final Office Action but reserved the right to make any subsequent final.

Next, the Applicant provided an overview of the present invention. Independent claims 1, 19, 23, 33, 37, and 38 were reviewed. Specifically, the discussion focused on the Examiner's statement on page 3 of the September 8, 2005 Office Action:

*"The collective system of Bro and Joao does not teach means for a third party provider to receive, process, and provide information regarding between at least one person and at least one—medical practitioners, wherein said information includes information necessary for a third party lender to finance at least one medical procedure for said person and whereby a portion of a fee charged by said medical practitioner for said medical procedure is paid by said medical practitioner to said third party provider in exchange for said third party brining (sic) together said person and said medical provider for said medical procedure which is financed by said third party lender."*

And the Examiner goes on to combine Bro and Joao with Boyer. There was no discussion whether such combination of these three references were even proper. The Applicant made the following three points:

- 1) The Examiner never points out where in Bro, Joao and Boyer

*"a portion of a fee charged by said medical practitioner for said medical*

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*procedure is paid by said medical practitioner to said third party provider in exchange for said third party bringing (sic) together said person and said medical provider for said medical procedure which is financed by said third party lender.* The Examiner points to Boyer (Figure 1, Col. 6, Ln 13-13 and Col. 8, Ln 50-52). Boyer is teaching a branded credit card system. No finder's fee is taught.

- 2) In light of the suggested clarifications in the independent claims the present invention is directed to pre-qualification of financing for medical procedures under consideration. Boyer is silent on pre-qualification and teaches payment after the service is rendered.
- 3) With regards to independent claim 38, the Examiner did not point out where the following limitation is found

means for said third party provider to receive, process and deliver medical status information from patients to medical practitioners, wherein said information includes information necessary for a third party lender to finance said medical procedure for said person and whereby a portion of a fee charged by said medical practitioner for said medical procedure is paid by said medical practitioner to said third party provider in exchange for said third party bringing together said person and said medical provider for said medical procedure which is financed by said third party lender.

Examiner Thomas discussed how this claim language is reviewed and suggested to positively recite these limitations as separate elements to further clarify the invention over the prior art references. The Applicant has agreed to make these limitations separate elements to clarify over the prior art of record.

Final Office Action Is Inappropriate In View of Newly Cited Art Boyer

Applicant has studied the Office Action dated September 8, 2005. Applicant respectfully requests entry of these remarks under the provisions of 37 C.F.R. § 1.116(a) in that the remarks below place the application and claims in condition for allowance, which allowance is respectfully requested. Claims 1-27, 33, 34, 37, 38, and 42 are pending. Reconsideration and allowance of the claims in view of the following

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remarks are respectfully requested.

As an initial matter, the Examiner made the Office Action final based on a new ground of rejection not stated in the earlier Office Action. Applicant respectfully traverses this decision. This is a RCE application. In the Final Office Action, the Examiner rejects the present claims by citing Bro ("Bro") in view of U.S. Patent No. 6,283,761, to Joao ("Joao"), and in further view of Boyer (U.S. 6,208,973). The Applicant respectfully points out that the Boyer reference was not cited in any the previous Office Action.

According to MPEP § 706.07(a): "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection not necessitated by amendment of the application by applicant, whether or not the prior art is already of record." In the previous Final Office Action dated July 1, , 2004, Examiner Kalinowski rejected claims 1-8, 15-27, 33, 34, 37, 38 and 42 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,249,809, to Bro ("Bro") in view of U.S. Patent No. 6,283,761, to Joao ("Joao").<sup>1</sup> In the previously-filed amendment with an RCE, the Applicant amended the independent claims 1, 19, 23, 33, 37, and 38 for clarity and to include an additional limitation of "a portion of a fee charged by said medical practitioner for said medical procedure is paid by said medical practitioner to said third party provider in exchange for said third party bringing together said person and said medical provider for said medical procedure which is financed by said third party lender." The Applicant did not switch from one subject matter to another or resort to any subterfuge to keep the application pending.<sup>1</sup> Thus it is respectfully submitted that the final status of the Office Action is premature and should be withdrawn.

If the Examiner does not withdraw the final status of the Office Action, Applicant submits that this response does not raise new issues in the application. It is submitted that the present response places the application in condition for allowance or, at least,

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<sup>1</sup> We note Examiner Kalinowski has been replaced by Examiner Kopplkar.

<sup>1</sup> See MPEP § 706.07.

presents the application in better form for appeal. Entry of the present response is therefore respectfully requested.

It is submitted that the application is in condition for allowance. Reconsideration and allowance of the pending claims in view of the following remarks are respectfully requested. No new matter has been added. In the Office Action, the Examiner:

- (1-3) rejected claims 1-8, 15-27, 33, 34, 37, 38 and 42 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,249,809, to Bro ("Bro") in view of U.S. Patent No. 6,283,761, to Joao ("Joao"), and in further view of U.S. 6,208,973 to Boyer ("Boyer");
- (4) rejected claims 9-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,249,809, to Bro ("Bro") in view of U.S. Patent No. 6,283,761, to Joao ("Joao") and further view of U.S. Pat. No. 5,935,060 to Iliff ("Iliff"); and
- (5) rejected claims 12-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Bro and Joao as applied to claim 1 above, and further in view of Lade, Diane, "Cyber Docs people with a wide range of medical problem are finding support online from doctors and other patients themselves" ("Cyber Docs").

#### Overview of the Current Invention

Preferred Embodiments of the present invention provide an improved method and apparatus for a third party provider to act as an intermediary between patients and medical practitioners. At the outset the present invention allows prospective patients who undergo elective and/or aesthetic procedures such as plastic surgery to understand costs including financing prior to contacting the medical practitioner. (See e.g. ¶0015). The system in the preferred embodiment, further provides a means for processing patient financial/credit data to a third party lender for medical procedure financing application processing. (See e.g. ¶0047). The system representative inputs a record of the patient prospect's concerns and questions 5.3 and the system generates an updated patient profile form 101 indicating the patient's personal, demographic, medical and credit approval information as well as the patient's noted questions and concerns, which is then transmitted 5.4 to the medical practitioner at least 24 hours

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prior to the appointment. (See e.g. ¶0069). The third party determines whether financing is required, can the prospective qualify for financing for the procedure under considerations. (See e.g. ¶0075). The third party provider manages the process of obtaining financing from third party lenders for the medical procedure. For compensation of having a new patient referred to a medical practitioner, the medical practitioner pays a "finder's fee" (i.e. a portion of a fee charged to the patient by the medical provider) which is paid to the third party provider as consideration for bringing together the patient and the medical provider with financing through a third party lender.

In order to more particularly point out this feature of pre-qualify financing for a medical procedure under consideration by a prospective patient along with paying a "finder's fee", the following language has been added to the independent claims, i.e., claims 1, 19, 23 33, 37 and 38 as follows:

means for pre-qualifying financing for at least one medical procedure under consideration by said person by a third party lender using said information;

means for paying a portion of a fee by said medical practitioner for said medical procedure to said third party provider in exchange for said third party bringing together said person and said medical provider for said medical procedure which is financed by said third party lender (*Italics added in previous amended*)

Support for this amendment is found in the specification as originally filed in FIGs. 3A, 4, 5 and 6 along with paragraphs 0015, 0047, 0069, 0075 in the published application US 2001/0021910.

(1-3) Claim Rejections under 35 U.S.C. § 103(a) Bro in view of Joao and Boyer

As noted above, the Examiner rejected claims 1-8, 15-27, 33, 34, 37, 38 and 42 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,249,809, to Bro ("Bro") in view of U.S. Patent No. 6,283,761, to Joao ("Joao"). Independent claims 1, 19, 23, 33, 37 and 38 have been amended to distinguish over Bro taken alone and/or in view of Joao and further view of Boyer. As the Examiner correctly states on page 3 of the Office Action:

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*The collective system of Bro and Joao does not teach means for a third party provider to receive, process, and provide information regarding between at least one person and at least one—medical practitioners; wherein said information includes information necessary for a third party lender to finance at least one medical procedure for said person and whereby a portion of a fee charged by said medical practitioner for said medical procedure is paid by said medical practitioner to said third party provider in exchange for said third party bringing (sic) together said person and said medical provider for said medical procedure which is financed by said third party lender”*

And goes on to combine Bro and Joao with Boyer. As suggested by Examiner Thomas, independent claims 1, 19, 23, 33, 37 and 38 have been amended to distinguish over Bro taken alone and/or in view of Joao and/or further view of Boyer to make the following elements as separate.

means for pre-qualifying financing for at least one medical procedure under consideration by said person by a third party lender using said information;  
means for paying a portion of a fee by said medical practitioner for said medical procedure to said third party provider in exchange for said third party bringing together said person and said medical provider for said medical procedure which is financed by said third party lender (Italics added in previous amended)

The Examiner points to Boyer (Figure 1, Col. 6, Ln 13-13 and Col. 8, Ln 50-52). Boyer is teaching a branded credit card system. No finder's fee is taught. Accordingly, independent claims 1, 19, 23, 33, 37 and 38 of the present invention have been amended to distinguish over Bro taken alone and/or in view of Joao and/or further view of Boyer and the Examiner's rejection should be respectfully be withdrawn.

Further independent claims 1, 19, 23, 33, 37 and 38 of the present invention have been amended to clarify “means for pre-qualifying financing for at least one medical procedure under consideration by said person by a third party lender using said information. Boyer taken alone and/or combined with Bro and Joao are silent on pre-qualification. In fact Boyer “teaches away” from pre-qualifying and teaches payment

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after the service is rendered. See Boyer Figure 1, Col. 6, Ln 13-13 and Col. 8, Ln 50-52. Where the prior art points away from the combination, modification or substitution of which is the premises of the PTO's alleged *prima facie* case of obviousness, there likewise is a built-in traversal of the rejection. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).<sup>2</sup> Accordingly, independent claims 1, 19, 23, 33, 37 and 38 of the present invention distinguish over Bro taken alone and/or in view of Joao and/or further view of Boyer for this reason as well.

Very recently, the Federal Circuit again took up the identical question of Obviousness in combining references in the case *In re Sang Su Lee*, No. 00-1158 (January 18, 2002) *In re Sang Su Lee*, 277 F.3d 1338 (Fed. Cir. 2002). In this case Board of Patent Appeals rejected all of Applicant's pending claims as obvious under § 103. The Federal Circuit vacated and remanded. Citing two prior art references, the Board stated that a person of ordinary skill in the art would have been motivated to combine the references based on "common knowledge" and "common sense," but it did not present any specific source or evidence in the art that would have otherwise suggested the combination. The Federal Circuit held that the Board's rejection of a need for any specific hint or suggestion in the art to combine the references was both legal error and arbitrary agency action subject to being set aside by the court under the Administrative Procedure Act (APA). Accordingly, with no suggestion or motivation found in Bro, Joao and Boyer of "pre-qualifying financing" and "paying a portion of a fee" as a finder's fee, the Examiner has failed to properly establish a *prima facie* case of obviousness of the invention as a "whole." The Applicants submit independent claims 1, 19, 23, 33, 37 and 38 of the present invention distinguish over Bro taken alone and/or in view of Joao

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<sup>2</sup> The Federal Circuit held a reference did not render the claimed combination *prima facie* obvious because *inter alia*, the Examiner ignored material, claimed temperature limitations which were absent from the reference. See MPEP §2143.01 In *In re Fine*, the claims were directed to a system for detecting and measuring minute quantities on nitrogen compounds comprising a gas chromatograph, a converter which converts nitrogen compounds into nitric oxide by combustion, and a nitric oxide detector. The primary reference disclosed a system for monitoring sulfur compounds comprising a chromatograph, combustion means, and a detector, and the secondary reference taught nitric oxide detectors. The examiner and Board asserted that it would have been within the skill of the art to substitute one type of detector for another in the system of the primary reference, however the court found there was no support or explanation of

and/or further view of Boyer for this reason as well.

In light of the foregoing, independent claims 1, 19, 23, 33, 37 and 38 of the present invention distinguish over Bro taken alone and/or in view of Joao and/or further view of Boyer. As claims 2-8, 15-18, 20-23, 24-27 and 42 depend from amended claims 1, 19, and 23 and necessarily include all the elements of their respective base claim, Applicant hereby respectfully submits that these claims are also patentable over the cited references at least for the same reasons and the Examiner's rejection should be withdrawn.

(4 - 5) Claim Rejections under 35 U.S.C. § 103(a) Bro, Joao in view of Iliff or CyberDocs

As noted above, the Examiner rejected claims 9-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,249,809, to Bro ("Bro") in view of U.S. Patent No. 6,283,761, to Joao ("Joao") and further view of U.S. Pat. No. 5,935,060 to Iliff ("Iliff") and rejected claims 12-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Bro and Joao as applied to claim 1 above, and further in view of Lade, Diane, "Cyber Docs people with a wide range of medical problem are finding support online from doctors and other patients themselves" ("Cyber Docs").

In view of the remarks in the section entitled "(1-3) Claim Rejections under 35 U.S.C. § 103(a) Bro in view of Joao and Boyer", independent claims 1, 19, 23, 33, 37 and 38 have been amended to distinguish over Bro taken alone and/or in view of Joao and further view of Boyer. Claims 9-11 depend from amended claim 1 and necessarily include all the elements of the base claim, Applicant hereby respectfully submits that these claims are also patentable over Bro taken alone and/or in view of Joao and/or in view if Iliff for the same reasons and the Examiner's rejection should be withdrawn.

Further, Claims 12-14 depend from amended claim 1 and necessarily include all the elements of the base claim, Applicant hereby respectfully submits that these claims are also patentable over Bro taken alone and/or in view of Joao and/or in view if Cyber

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this conclusion and reversed.

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Docs for the same reasons and the Examiner's rejection should be withdrawn.

### **CONCLUSION**

The remaining cited references have been reviewed and are not believed to affect the patentability of the claims as amended.

In this Response, Applicant has amended certain claims. In light of the Office Action, Applicant believes these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicant respectfully submits that the claim amendments do not limit the range of any permissible equivalents.

Applicant acknowledges the continuing duty of candor and good faith in the disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment is limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicant and his attorneys.

Applicant respectfully submits that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

**PLEASE CALL** the undersigned if it would expedite the prosecution of this application.

Respectfully submitted,

Date: December 8, 2005

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